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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Application of:

)Attorney Docket No.: F-673

Felix Bator et al.

)Group Art Unit: 3628

Serial No.: 10/626,850

)Examiner: I. Borissov

Filed: July 22, 2003

)Date: December 7, 2006

Confirmation No.: 1866

Title: System and Method for Instant Online Postage Metering

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1-3 and 9-14 of the above-identified application mailed July 12, 2006. The fee for submitting this Brief is \$500.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of \$500.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required or credit any overpayment to Deposit Account No. **16-1885**.

CERTIFICATE OF MAILING	
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Mail Stop Appeal Briefs - Patents Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450	
on <u>December 7, 2006</u> Date of Deposit	<u>Amy Harvey</u> Name of Rep.
<u>Amy Harvey</u> Signature	<u>December 7, 2006</u> Date

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 4-8 have been cancelled. Claims 1-3 and 9-14 are pending in this application. Claims 1-3, 9, 10 and 12-14 stand rejected under U.S.C. § 102(b) as being anticipated by Shah et al. (U.S. 5,822,738). Claims 3 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah et al. in view of Official Notice.

IV. Status of Amendments

There were no amendments to the claims filed subsequently to the Office Action dated July 12, 2006. Therefore, the claims as set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Claimed Subject Matter

This summary and references to specific page and line numbers, figures and reference characters is not intended to supplant or limit the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

Appellants' invention is directed to system and method that allows instant metering of online postage. A problem with conventional virtual metering is that customers, i.e., mailers, using a virtual postage metering system to evidence postage on mail have to obtain a meter license for a meter account with a dedicated origin zip code. This meant the mailer had to go through a registration process with the United States Post Office (USPS) and wait for approval from the USPS for a meter license before the mailer was allowed to print postage obtained over the Internet. This delay, due to the mailer having to wait for approval for a meter license from the USPS before being able to print postage from a PC, can act as a deterrent to mailers to utilize PC postage. (Specification, paragraphs [0009] and [0023]).

The present invention alleviates the problems of the prior art by providing a system and method that allows instant metering of online postage. In accordance with the present invention, a mailer can print postage on a PC printer without having a meter license or meter account. In one embodiment, a meter account is licensed to a vendor (and not the individual mailer) for dispensing postage to customers from a plurality of origin zip codes. A vendor meter account 50 is located at a remote Data Center 30. The meter account 50, which is assigned to the vendor, dispenses postage payment evidence to a plurality of customers 25. (Specification, paragraph [0031]).

In view of the above, independent claim 1 recites a method for a vendor to dispense postage over a network to a remote personal computer that comprises "obtaining a meter license from the Post, said meter license being associated with a meter account assigned to the vendor, said meter account being maintained at a data center" (see Fig. 3, step 100, and corresponding description in paragraph [0032] and Fig. 1, item 30 and corresponding description in paragraph [0029]); "receiving, via the network, a transaction request for postage from a customer using the remote personal computer, said transaction request including information from the customer, said information corresponding to the transaction requested and payment method" (see Fig. 3,

steps 108 and 112 and corresponding description in paragraph [0032]); “processing the requested transaction by requesting the data center to create evidence of postage payment and to account for the created evidence of postage payment in the meter account assigned to the vendor; effecting payment for the transaction based on the information received from the customer” (see Fig. 3, step 116 and corresponding description in paragraph [0032]); “receiving the evidence of postage payment created by the data center; and sending the evidence of postage payment to the remote personal computer for use by the customer.” (See Fig. 3, step 120 and corresponding description in paragraph [0032]).

Independent claim 10 is directed to a method for a vendor to dispense postage to a remote personal computer via a network that comprises “receiving a request for postage from a customer using the remote personal computer coupled to the network” (see Fig. 3, steps 108 and 112 and corresponding description in paragraph [0032]); “processing the request for postage by requesting a data center to create evidence of postage payment and to account for the created evidence of postage payment in a postal account assigned to the vendor” (see Fig. 3, step 116 and corresponding description in paragraph [0032]); and “sending the evidence of postage payment to the remote personal computer via the network for use by the customer.” (See Fig. 3, step 120 and corresponding description in paragraph [0032]).

Independent claim 14 is directed to a system for dispensing postage over the Internet to a remote personal computer for printing that comprises “a data center accessible over the Internet” (see Fig. 1, item 30 and corresponding description in paragraphs [0024-0025]; “at least one metering account licensed to a vendor and maintained at the data center” (see Fig. 2, item 50 and corresponding description in paragraph [0031]; “means at the data center for receiving over the Internet a request for postage, the request being initiated by a customer of the vendor using the remote personal computer” (see Fig. 1, item 32 and corresponding description in paragraph [0027]; “means at the data center for generating evidence of postage payment in response to the request for postage” (see Fig. 1, item 34 and corresponding description in paragraph [0027]; and “means at the data center for accounting for the generated evidence of postage payment in the metering account licensed to the vendor.” (See Fig. 1, items 34-38 and Fig. 2, item 50 and corresponding description in paragraphs [0027] and [0031].

Additional features of the invention are discussed below in the Argument section of this Brief.

VI. Grounds of Rejection to be Reviewed on Appeal

A. Whether the subject matter defined in claims 1-3, 9, 10 and 12-14 is anticipated by Shah et al. (U.S. 5,822,738).

B. Whether the subject matter defined in claims 3 and 11 is unpatentable over Shah et al. in view of Official Notice.

VII. Argument

As Appellants discuss in detail below, the final rejection of claims 1-3 and 9-14 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The subject matter defined in claims 1-3, 9, 10 and 12-14 is not anticipated by Shah et al. (U.S. 5,822,738).

Shah et al. (U.S. 5,822,738) is directed to a modular postage accounting system in which a general purpose computer, a digital printer and a secure metering device (SMD) can be used to print postage. The SMD performs the accounting functions of a postage meter and generates encrypted postage indicia data for transmission by the computer to the digital printer and subsequent printing on a mailpiece. Alternatively, the SMD functions may be embedded within a computerized meter resetting system (CMRS). Before a user can utilize the device in Shah, the user must obtain a license from the postal service and have a postal account established for the user by the postal service. As noted in Shah, “A user who has obtained the required license from the postal service can contact with the meter company to interface the user’s general

purpose computer to the CMRS computer via modem and telephone line.” (Col. 2, lines 13-16, emphasis added).

Thus, in Shah, the customer must obtain the proper meter license from the post and establish an associated meter account assigned to the customer with the post. This is in direct contrast with the present invention, in which a customer can print postage utilizing a meter account assigned to the vendor instead of a meter license or meter account assigned to the customer. In Shah the accounting performed for any postage generated is done using an account assigned to the user. A multi-site user’s individual sites can process mail continuously, with payment to the post office and replenishment of credit handled through central accounting facilities. As long as the user’s central accounting facility maintains adequate fund reserves, the individual sites have access to an on-line service which provides postage on an as-needed basis. (Col. 2, lines 55-61). Each user must, therefore, have a meter account with the postal service in order to print postage.

There is no disclosure, teaching or suggestion in Shah of a “meter license being associated with a meter account assigned to the vendor” as is recited in claim 1. Furthermore, there is no disclosure, teaching or suggestion in Shah of dispensing postage in response to a transaction request received by a vendor over a network from a customer that includes “processing the requested transaction by requesting the data center to create evidence of postage payment and to account for the created evidence of postage payment in the meter account assigned to the vendor” as is recited in claim 1.

The Office Action contends that the language of the claims does not prevent the customer to have the meter license or meter account assigned to the customer. (Office Action, page 6). Claim 1 clearly recites that the meter license is associated with a meter account assigned to the vendor and that the created evidence of postage payment is accounted for in the meter account assigned to the vendor. The Office Action has not provided any basis for the contention that the claim does not prevent the customer from having the meter license or meter account assigned to the customer, since the claim clearly recites that the meter license and meter account are assigned to the vendor.

The Office Action further contends that Shah explicitly discloses the feature of the meter license or meter account being assigned to the vendor in Col. 1, lines 46-51 and Col. 2, line 10-17. Appellants respectfully disagree. Col. 1, lines 42-51, is reproduced below.

In contrast, modem electronic meters are often capable of being reset directly by an authorized party, on-site (at the user's location) via a communications link. A system which performs meter resetting in this manner is known as a Computerized Meter Resetting System (or "CMRS"). The party having authority to reset the meter and charge the customer (usually the manufacturer or the postal authority) thus gains access to and resets the meter.

This paragraph relates to recharging the meter with additional postage funds. Note, however, that the account is still assigned to the customer. There is nothing in this paragraph that discloses the account being assigned to the vendor. If the user has not obtained a proper meter license, the user will never be able to recharge the meter. The Office Action has not provided any indication of where in this passage it is explicitly, or even implicitly, disclosed that a meter license or meter account is assigned to the vendor instead of to the customer as is traditionally done.

Col. 2, lines 10-17, of Shah are reproduced below.

In another embodiment, the present invention eliminates that requirement by embedding the SMD functions within the CMRS computer system. A user who has obtained the required license from the postal service can contract with the meter company to interface the user's general purpose computer to the CMRS computer via modem and telephone line.

This passage clearly states "A user who has obtained the required license from the postage service and contract with the meter company . . ." This passage explicitly discloses that the meter license is associated with a meter account assigned to the customer (user) and not the vendor as is recited in claim 1. The Office Action has not provided any indication as to how this passage, which explicitly requires the user to obtain a meter license, can be interpreted to disclose that the vendor obtains the meter license.

For at least the above reasons, Appellants respectfully submit that the final rejection as to claim 1 is in error and should be reversed. Claims 2, 3 and 9 are dependent upon claim 1, and

therefore include all of the limitations of claim 1. For the same reasons the final rejection as to claim 1 is in error, Appellants respectfully submit that the rejection of claims 2, 3 and 9 is similarly in error and should be reversed.

Claims 10 and 14 include limitations substantially similar to claim 1. For the same reasons given with respect to claim 1 above, Appellants respectfully submit that the final rejection as to claims 10 and 14 is in error and should be reversed. Claims 12 and 13 are dependent upon claim 10, and therefore include all of the limitations of claim 10. For the same reasons the final rejection as to claim 10 is in error, Appellants respectfully submit that the rejection of claims 12 and 13 is similarly in error and should be reversed.

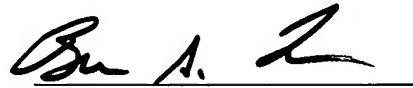
B. The subject matter defined by claims 3 and 11 would not have been obvious over Shah et al. in view of Official Notice.

Claim 3 is dependent upon claim 1, and therefore includes all of the limitations of claim 1. Claim 11 is dependent upon claim 10, and therefore includes all of the limitations of claim 10. The Official Notice relied upon by the Office Action does not cure any of the deficiencies noted above with respect to claims 1 and 10, as it was relied upon for other features. For the same reasons given above with respect to claims 1 and 10, Appellant respectfully submits that the rejection of claims 3 and 11 is similarly in error and should be reversed.

VIII. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-3 and 9-14 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Brian A. Lemm", written over a horizontal line.

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Attachments - Appendix A – Claims Appendix (2 pages)
Appendix B – Evidence Appendix (1 page)
Appendix C – Related Proceedings Appendix (1 page)

APPENDIX A – Claims Appendix

1. A method for a vendor to dispense postage over a network to a remote personal computer, the method comprising:

obtaining a meter license from the Post, said meter license being associated with a meter account assigned to the vendor, said meter account being maintained at a data center;

receiving, via the network, a transaction request for postage from a customer using the remote personal computer, said transaction request including information from the customer, said information corresponding to the transaction requested and payment method;

processing the requested transaction by requesting the data center to create evidence of postage payment and to account for the created evidence of postage payment in the meter account assigned to the vendor;

effecting payment for the transaction based on the information received from the customer;

receiving the evidence of postage payment created by the data center; and

sending the evidence of postage payment to the remote personal computer for use by the customer.

2. The method of claim 1, further comprising:

determining an origin of deposit postal code for the requested transaction.

3. The method of claim 1, wherein the information from the customer includes a username, password and credit card information whereby a personal account is established for subsequent transactions.

Claims 4-8. Cancelled.

9. The method of claim 2, wherein the origin of deposit postal code is included in the information from the customer.

10. A method for a vendor to dispense postage to a remote personal computer via a network comprising:

receiving a request for postage from a customer using the remote personal computer coupled to the network;

processing the request for postage by requesting a data center to create evidence of postage payment and to account for the created evidence of postage payment in a postal account assigned to the vendor; and

sending the evidence of postage payment to the remote personal computer via the network for use by the customer.

11. The method of claim 10, wherein the evidence of postage payment includes a transaction number.

12. The method of claim 10, wherein receiving a request for postage from a customer further comprises:

receiving information to identify the customer.

13. The method of claim 12, wherein the information to identify the customer includes at least one of a user name and a password.

14. A system for dispensing postage over the Internet to a remote personal computer for printing, the system comprising:

a data center accessible over the Internet;

at least one metering account licensed to a vendor and maintained at the data center;

means at the data center for receiving over the Internet a request for postage, the request being initiated by a customer of the vendor using the remote personal computer;

means at the data center for generating evidence of postage payment in response to the request for postage; and

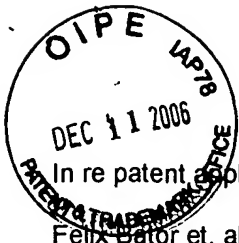
means at the data center for accounting for the generated evidence of postage payment in the metering account licensed to the vendor.

APPENDIX B – EVIDENCE APPENDIX

There is no evidence submitted pursuant to §§ 1.130, 1.131, or 1.132 or any other evidence entered by the examiner and relied upon by Appellant in the appeal.

APPENDIX C – RELATED PROCEEDINGS APPENDIX

There are no appeals or interferences known to Appellants, their legal representative, or the assignee which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of:

Felix Bator et. al.

) Date: December 7, 2006

) Attorney Docket No.: F-673

Serial No.: 10/626,850

) Customer No.: 00919

Filed: July 22, 2003

) Group Art Unit: 3628

Confirmation No.: 1866

) Examiner: I. Borissov

Title: SYSTEM AND METHOD FOR INSTANT ONLINE POSTAGE METERING

TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION 37 CFR 1.192)

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
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Sir:

Transmitted herewith is the **APPEAL BRIEF** in the above-identified patent application with respect to the Notice of Appeal filed on October 11, 2006.

Pursuant to 37 CFR 41.20(b)(2), the fee for filing the Appeal Brief is \$500.00

Please charge Deposit Account No. **16-1885** in the amount of \$500.00 to cover the above fees.

The Commissioner is hereby authorized to charge any additional fees which may be required to Deposit Account No. **16-1885**.

A duplicate copy of this transmittal is enclosed for use in charging the Deposit Account.

Respectfully submitted,

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Date of Deposit

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Name of Person Certifying